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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,013	01/29/1999	YOICHI TAKARAGI	35.G2349	5593
5514	7590	03/24/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			AHMED, SAMIR ANWAR	
			ART UNIT	PAPER NUMBER
			2623	29

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,013

Applicant(s)

TAKARAGI, YOICHI

Examiner

Samir A. Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amnd.10/31/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-19,21-26,28,29 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment filed 10/31/03 have been entered and made of record.
2. Applicant's arguments filed 10/31/03 have been fully considered but they are moot in view of new grounds for rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-8, 10-15, 17-19, 21—26, 28-29, 41-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites, " first addition means for adding first identification information to the image data, wherein the first identification information is formed by a first color signal", lines 3-4, "generating means comprises color conversion on the image data including the first identification information and forming means for forming the second identification information by a second color signal different from the first color signal forming the color-converted first identification information in the color-converted image data", lines 16-20". There is no recitation any where in the specification as originally filed of the combination of the above features as claimed. More specifically, as disclosed in the specification as originally filed a watermark (first identification

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information) is added to the input image data via the red color signal (first color) of the scanner. A printer is used to print the printer's serial number (second identification information) in yellow (a second color signal), the red signal (first color) of the scanner is converted into yellow color signal (y) which is used to print the watermark (color converted first identification information) in a thin yellow (different color tone) different from the yellow color of printer's serial number (second identification information) (specification, page 7, lines 11-15, page 12, line 6 to page 13, line 11). It is clear that "a first color signal for adding the first information to image data" on lines 3-4 (i.e., the scanner's red color) cannot be "the first color forming the color-converted identification in the color converted image data" on lines 19-20 (i.e., the printer's thin yellow".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-8, 10-15, 17-19, 21—26, 28-29, 41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites "" first addition means for adding first identification information to the image data, wherein the first identification information is formed by a first color signal", lines 3-4, and "forming the second identification information by a second color signal different from the first color signal forming the color-converted first identification information in the color-converted image data", lines 18-20. It not clear whether "a first color signal" on line 4 is the same or different from "the first color signal" on line 19, which is a explained above is not and cannot refer to it.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-8, 10-15, 17-19, 21—26, 28-29, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada (US Patent 5,257,119) in view of Wen (US Patent 5,582,660). The grounds for rejections stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to claim 1 [as best understood by the Examiner], refer to claim 2 rejection stated in paragraph 5 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to claims 3-7 refer to claim 3-7 rejections in paragraph 5 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to claim 8 [as best understood by the Examiner], refer to claim 1 rejection.

As to claims 10-14 refer to claim 3-7 rejections

As to claim 15 [as best understood by the Examiner], refer to claim 1 rejection.

As to claims 17-18 refer to claim 3-4 rejections.

As to claim 19 [as best understood by the Examiner], refer to claim 1 rejection.

As to claims 21-25 refer to claim 3-7 rejections.

As to claim 26 [as best understood by the Examiner], refer to claim 1 rejection.

As to claims 28-29 refer to claim 3-4 rejections.

As to claim 41 [as best understood by the Examiner], refer to claim 1 rejection.

As to claims 42-43 refer to claim 3-4 rejections.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir A. Ahmed whose telephone number is 703-305-9870. The examiner can normally be reached on Mon-Fri 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SA



**SAMIR AHMED
PRIMARY EXAMINER**